



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,012	02/01/2005	Joachim Moormann	3868-0160PUS1	7480
2292 7590 04/22/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
PALENIK, JEFFREY T				
ART UNIT		PAPER NUMBER		
1615				
NOTIFICATION DATE		DELIVERY MODE		
04/22/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/523,012

Applicant(s)

MOORMANN ET AL.

Examiner

Jeffrey T. Palenik

Art Unit

1615

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 April 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 2 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,3-6,8,9,20 and 21.
Claim(s) withdrawn from consideration: 10,11,13-16,18,19 and 22.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Jeffrey T. Palenik/
Examiner, Art Unit 1615

Continuation of 3. NOTE: Applicants' response, including Exhibit A, have been fully considered by the Examiner. Regarding Exhibit A, it should be noted that this document has been entered on the record as an affidavit. Said Exhibit, while having been considered, is NOT considered a formal affidavit, particularly since it is not a sworn statement. Rather the Exhibit is data which is presented in support of Applicants remarks. However, the amendments made to the claims, namely to both claims 1 and 5, would be persuasive enough to overcome the rejection as discussed below (see comments to 5). However, neither the amendments, nor the remarks and evidence (e.g. Exhibit A) will not be entered on the record because the proposed amended claims raise new issues not previously addressed and would necessitate a new search.

Continuation of 5. Applicant's reply has overcome the following rejection(s): As noted in 3(a) above, the amendments made to claims 1 and 5, were they to be entered on the record would be sufficient to render moot the rejection to claims 1, 2, 4-6, 8, 9, 20 and 21, under 35 USC 103(a) as being unpatentable over the combined teachings of Biberman et al. (US Pre-Grant Publication No. 2002/0019421) and Plata-Salaman (US Pre-Grant Publication No. 2003/0060423), Thereby resulting in the withdrawal of the rejection. The amendment removing the phrase "capable of being" from claim 9, were it to be entered on the record would be sufficient enough to render moot the rejection to claim 9 under 35 USC 112, second paragraph, thereby resulting in the withdrawal of the rejection.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' amendment to claim 1 incorporates the subject matter of the previously rejected claim 2. However, the subject matter which was incorporated into the independent claim has been narrowed in scope such that the nicotinic receptor modulator is now selected from a group consisting of galanthamine and the pharmacologically acceptable salts of galanthamine. Previously, the limitation of claim 2 also recited nicotine and its pharmacologically acceptable salts as nicotinic receptor modulators. Similarly, the amendment to claim 5, removes the limitation which recites the release of 5-50 mg of nicotine, thereby narrowing the scope of the rejected claim. Thus while Applicants' amendments do overcome the art currently made of record, it also more critically narrows the scope of the independent claim, as well as dependent claim 5, thereby necessitating a new/additional search by the Examiner.

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615